



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,481	06/27/2001	Kazumi Suga	1232-4730	5929

27123 7590 04/25/2005
MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,481

Applicant(s)

SUGA, KAZUMI

Examiner

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39 and 50 is/are pending in the application.
4a) Of the above claim(s) 40-49 and 51 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 34-39 and 50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 34-51 in the response filed 11 January 2005 is acknowledged. The traversal is on the ground(s) that undue searching should not be required. This is not found persuasive because Examiner believes that the restriction is proper since the subcombinations are distinct from each other and are shown to be separately usable. In the instant case, invention I (claims 34-39 and 50), classified in class 705/37, has separate utility such as trading electronic contents between buyers and sellers and conducting a transaction. Invention II (claims 40-49 and 51), classified in class 705/10, has separate utility such as using software for evaluating electronic contents. Examiner notes that it would be a serious burden to search all three inventions given their separate status in the art as noted above.
2. The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
3. Claims 40-49 and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the response filed 11 January 2005.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 3621

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 34-39 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U.S.

Patent No. 6,343,738 B1 in view of Kopelman et al, U.S. Patent Application Publication No. US

2004/0138966 A1.

As per **Claims 34, 37 and 50**, Ogilvie discloses an information processing system capable of sending electronic contents between a buyer-side apparatus and seller-side apparatus via a network, comprising:

- a software program for evaluating the electronic contents by the seller-side apparatus (Col. 13, lines 25-35);

- first receiving means for receiving first information sent from the seller-side apparatus, the first information being a result evaluated by the seller-side apparatus (Figures 5 and 8; Col. 2, lines 15-26; Col. 11, lines 35-67; Col. 13, lines 25-35; Col. 14, lines 5-12; Col. 14, lines 57-63);

- second sending means for sending apparatus the received first information to the buyer-side apparatus (Figure 8; Col. 12, lines 50-60; Col. 14, lines 5-12; Col. 14, lines 57-63);

- second receiving means for receiving second information sent from the buyer-side apparatus, the second information containing a data relevant to purchase (Col. 6, lines 50-60; Col. 12, lines 15-27; Col. 25, lines 43-50; Col. 26, lines 27-35);

- third sending means for sending the received second information to the seller-side apparatus (Col. 12, lines 15-27; Col. 25, lines 43-50; Col. 26, lines 27-35);

Art Unit: 3621

- third receiving means for receiving the electronic contents sent from the seller-side apparatus in response to the reception of the second information (Col. 6, lines 35-50; Col. 25, lines 43-50; Col. 26, lines 27-35);

- fourth sending means for sending the received electronic contents to the buyer-side apparatus (Col. 12, lines 15-27; Col. 25, lines 43-50; Col. 26, lines 27-35).

Ogilvie discloses the use of a software program to evaluate the electronic contents such as generating samples of the content (Col. 13, lines 25-35), however, fails to specifically disclose sending the software program from the information processing system to the seller-side apparatus. Examiner submits, however, that it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to provide the software tools to the seller apparatus for evaluating/inspecting the electronic contents and generating samples. These software tools are conventionally known as disclosed by Ogilvie and it would have been obvious for the seller to acquire these tools or to provide the seller these tools by the system.

As per **Claims 35 and 38**, Ogilvie further discloses the use of encryption for encrypting information transmitted between the participants (Col. 9, lines 65-67; Col. 17, lines 56-61; Col. 20, lines 40-50).

As per **Claims 36 and 39**, Ogilvie fails to explicitly disclose a means for sending a cryptography key to the seller side apparatus and wherein the received electronic contents have been encrypted by using the cryptography key. Ogilvie does disclose, however, that encryption and the use of public keys are familiar tools that can be used to provide secure communications between the parties and the broker. Examiner takes Official Notice that using a cryptography key that is provided to the parties is well known in the art and it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use a cryptography key in order to encrypt the communications between the parties in an effort to secure the information.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kopelman et al disclose a method for facilitating sales of goods by independent parties and teaches a method of evaluating the items being marketed.

Art Unit: 3621

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (571)272-6708. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (571)272-6712.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks

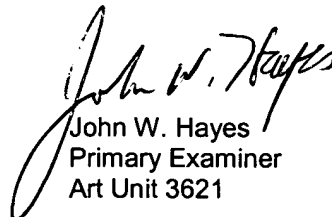
Washington, D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(571) 273-6708 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

April 18, 2005